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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,013	05/06/2004	William H. Thompson III	BBRI / 02U	9636

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EXAMINER	
PRICE, RICHARD THOMAS JR	

ART UNIT	PAPER NUMBER
3643	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/840,013	THOMPSON ET AL.	
	Examiner	Art Unit	
	Thomas Price	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2005 and 19 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-12 and 14-22* is/are pending in the application.

4a) Of the above claim(s) *14-19,21 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-12 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The Examiner acknowledges the Applicant's election with traverse of claims 1-3 and 6-12. The Examiner agrees with the Applicant that newly added claim 20 is dependent upon elected claim 7, and as a result, is included in the election of Group I. In regards to the Applicant's argument concerning whether or not the process as claimed can be practiced by hand, the Examiner draws the Applicant's attention to the claimed terms specific to the process. First, the method step or process of "providing" a feather assembly, clearly can be performed by hand. It is not that the hand has to be structure claimed, it is the process or steps being claimed. Secondly, the claimed step of "securing" is performed by hand. However, for the sake of argument, the Examiner can set aside whether or not the process can be performed by hand. And easily, a second approach can be taken, the apparatus can be used to perform a different task, such as a decoration to be hung in a porch, a piece of rare art to be placed in a museum, a memorial for birds in a park; or a teaching tool for children on how objects rotate about one another. Despite this, one could look at it from another way, such as the process being performed by a different apparatus. Well, one could put flashing lights in front of the window, a picture of an angry and hungry owl on the window, a computer guided laser pointer, a screaming child building a gigantic snowman in front of the window, wooden slats, plant a tree, etc.....The Examiner strongly disagrees with the Applicant's comments "Applicants respectfully assert that the guidelines of the MPEP with respect to process and apparatus restriction requirements have not been

followed", on the contrary, the MPEP clearly supports the Examiner's position concerning the process and apparatus restriction requirements. The Examiner would also like to thank the Applicant "respectfully reminding" the Examiner "selected" quotes and rules of the MPEP. As to whether the Restriction requirement is untimely and the Applicant's statement of "caution, the Examiner "respectfully reminds" the Applicant that the Examiner can put forth a restriction at any time before a final rejection. Lastly, because the restriction is proper and the inventions are distinct and have acquired a separate status in the art because of their recognized divergent subject matter proves that a "serious burden" exists.

Drawings

The Examiner thanks the Applicant for correcting various reference numerals which were not shown in the drawings, specifically, 10a, 10b, 18a, 18b, 22a and 22b. The Examiner approves entry of these corrections to the drawings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel U.S. 1,177,960.

Michel teaches a feather trimming which is structurally similar to the Applicant's claimed feather assembly for preventing birds from flying into a window. Michel teaches a length of line 2, and a plurality of feathers secured to said line at spaced locations. Michel does not specifically discuss the bright colors of the individual feathers, but does discuss on column 2, lines 81 and 82, that a variety of colors can be used. As a result, one of ordinary skill in the art at the time the invention was made realizes that any and all types of feathers can be used. And, one of ordinary skill knows that the feathers range in color from brightly colored to dull color shades. So, in regards to claim 1, to choose a bright colored feather would have been obvious to a person of ordinary skill in the art at the time the invention was made because it is considered to be an aesthetic factor as opposed to a patentably distinguishable factor. In regards to claim 1, the specific way in which to attach the feathers to the line is believed to be obvious to a person of ordinary skill in the art at the time the invention was made. Regarding claim 2, Michel does not teach a nylon monofilament, however, the cord material of Michel could encompass a variety of materials. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use nylon monofilament for the cord of Michel, because nylon monofilament is a widely regarded line or cord material, and is considered to be structurally equivalent to the undisclosed cord material of Michel. As for claim 3, the length of the line is considered to be an aesthetic factor to one of ordinary skill in the art at the time the invention was made in that it is directed more towards artistry than patentable distinction. Regarding claim 6, to provide

additional coloring to the feathers lends itself to individual artistic choice and is thus deemed to be obvious.

Claims 7-11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel U.S. Patent 1,177,960 in view of Boston et al U.S. Patent 4,588,153. Michel does not teach hanging decorative trimmings from glass using suction cups. Boston et al teach hanging decorative trimmings from glass using suction cups positioned about the length and ends of a length of line. Further, opposite ends of the line are secured to the suction cup anchors, respectively. See the above mentioned discussion of the reference to Michel for the respective teachings. Regarding claim 7, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the line trimmings of Michel with suction cups, in view of the teachings of Boston et al, in order to decorate on a glass structure, whether it be the glass on an armoire or a window of a house. Regarding claims 14 and 15, the specific position of the combination Michel as modified by Boston et al with respect to the window is considered to be an artistic choice which does not rise to the level of patentable distinction. As for claims 16 and 17, given that suction cups over time will slide due to the weight of the decorative line, the resultant decorative line will have sufficient slack to enable the feathers to sway in a breeze.

Response to Arguments

In regards to the Applicant's argument concerning "brightly colored feathers", the reference to Michel teaches a variety of feathers can be used. It is known that the broad spectrum of feathers includes brightly colored feathers, i.e. parrot feathers. Michel

clearly teaches that any variety of feathers can be used. As for the Applicant's argument concerning claim 6 and "artificial feathers", technically artificial feathers broadly read on "any variety of feathers", etc... And as such, to use artificial as opposed to real feathers just does not rise to the level of invention. Both types of feathers quite honestly are structurally equivalent. Regarding claims 1 and 20, and the Applicant's comments concerning how the feathers are attached to the line, the Examiner can find no support for such claim language having novelty, on the contrary, the Applicant discusses the opposite, in that, any method of attachment can be used. On page 3, lines 12 and 13, the Applicant states "Any other method may be used to fix the location of the feather along the length of the line." . The Applicant further argues the proposed patentable distinction of how the feathers are attached to the line. However, "the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even thought the prior product was made by a different process". This is evidenced by the Applicant's own admission "Any other method may be used to fix the location of the feather along the length of the line." Certainly, the reference to Michel is in agreement with the Applicant's assertions. As a result, the method of attachment of the reference to Michel is believed to be structurally equivalent to the method of securing as claimed by the Applicant. In regards to the Applicant's comments to claim 7, the reference to Boston clearly teaches how to attach a decoration to glass, and the reference to Michel can be considered to be a decoration. Further, the reference to Boston was not cited to teach "a wire having

brightly.....etc...etc. because that is what the reference to Michel teaches. As to claim 14 and the Applicant's arguments concerning such, see the above mentioned discussion. Regarding claim 16, the combination of Michel as modified by Boston will inherently allow the feathers to sway in the wind, and over time the line will become slack due to the cups sliding or the natural tendency of the line to become slack. Further, the specification does not explain in detail the condition of "slack" in that, there is a fine line between something being slack versus tight. Clearly, the combination of Michel as modified by Boston is not under tension. Therefore, the line is inherently slack. What exact is the breadth and meaning of the Applicant's term "slack". Also, the term "sway" is highly relative. Doesn't this depend on the wind speed? Does the Applicant define when and how this line sways. Is the Applicant trying to claim a specific wind speed in order to more clearly define the term "sway". It appears the Applicant is trying to use weather conditions to patentably distinguish the Applicant's claimed invention over the prior art of record.

Response to Amendment

Applicant's arguments filed 2-21-2005 and 5-19-2005 have been fully considered but they are not persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Summary: Claims 1-3, 6-12 and 20 are rejected, while claims 14-18, 19, 21 and 22 are withdrawn as directed to a non-elected claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Price whose telephone number is 571-272-6892. The examiner can normally be reached on Monday through Friday from 8:30a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Price
Primary Examiner GAU: 3643

rtp